

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Michael Reed et al.

Application No.: 08/113,955

Confirmation No.: 3543

Filed: August 31, 1993

Art Unit:

For: MULTIMEDIA SEARCH SYSTEM

Petitions Examiner: David Bucci

**REQUEST FOR RECONSIDERATION/PETITION FOR SUPERVISORY REVIEW OF
DECISION DENYING PETITION FOR A FILING DATE**

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The decision mailed by the USPTO on March 4, 2009 ("2009 Decision") denying Applicant's Request for a filing date to be accorded to the above-captioned application included a footnote on page 12 to the effect that the Decision may be viewed as a final agency decision for purposes of seeking judicial review.

In the Notice to PTO Regarding Decision Denying Petition for a Filing Date, filed March 12, 2009, Applicant indicated that, after a close review of the 2009 Decision, Applicant is of the opinion that the USPTO did not treat the record before it in a manner consistent with the statute, USPTO regulations, or the policy of the USPTO and that Petitioner would present additional evidence in the form of a Declaration from a prior USPTO official (Mr. Jeffrey V. Nase) which will reinforce the

view that the USPTO is incorrectly refusing to grant a filing date in the present application. Now comes this Request for Reconsideration/Petition for Supervisory Review, which Request/Petition is being filed within the two month period provided under 37 C.F.R. § 1.181(f).

This Request/Petition is based upon the following errors committed by the USPTO in:

- (a) initially not according a filing date to this application when it was filed August 31, 1993, based upon a fatally flawed policy that was disavowed by the USPTO on July 22, 1996;
- (b) inconsistently not according a filing date, even based upon its flawed policy and violating its own stated procedure, when it dismissed on February 16, 1994, a petition grantable on its face, that requested the August 31, 1993 filing date, by improperly making the filing date grant contingent upon the filing of a supplemental oath or declaration, which condition was in direct violation of the applicable statute, regulation and the USPTO's own stated procedure;
- (c) continuing to rely upon that flawed, disavowed procedure in maintaining the refusal to grant this application a filing date;
- (d) continuing to refuse to remedy the improper failure to grant a filing date by failing to acknowledge the USPTO's numerous positive, documented, official acts that caused or contributed to Applicant's failure to appreciate that further action was in any way required in this application.

A. ARGUMENTS AS TO WHY THIS APPLICATION WAS, AND STILL IS, ENTITLED TO THE AUGUST 31, 1993 FILING DATE

1. Application Was Entitled to Filing Date Under the Statute and Regulations

The 2009 Decision of the USPTO indicated that, as this application was deposited with the USPTO on August 31, 1993, the statutes, rules, and procedures in effect at the time of the deposit of the application control and that Petitioner cannot rely upon later promulgated statutes, rules, and procedures to support his assertions that a filing date of August 31, 1993 be granted to the instant application. The 2009 Decision cites 35 U.S.C. § 111 and 37 C.F.R. § 1.53(b) and 1.53(d) in support of the statute and rule in effect at the time of the filing of this application.

What the 2009 Decision fails to appreciate, however, is that this application was (and continues to be) entitled to a filing date under that same statute and regulation. It was only due to the USPTO's clearly erroneous procedure that a filing date was not granted. However, as the record below shows, by July 22, 1996, the USPTO had replaced that flawed procedure.

As set out in 35 U.S.C. § 111 and 37 C.F.R. § 1.53(b) (in effect August 31, 1993), a filing date will be accorded an application which includes a specification as prescribed by 35 U.S.C. § 112, at least one claim, and any drawing required by 37 C.F.R. § 1.81(a). This application, as filed on August 31, 1993, did in fact meet the requirements of the statute and rule for the granting of a filing date for this application in that it included a specification, at least one claim and drawings. In support of Applicants' position that this application is entitled to the requested August 31, 1993 filing date, then and now, Petitioner proffers herewith the Declaration of Mr. Jeffrey Nase, who was the Director of the Office of Petitions in 1993 and in 1994 became the Patent Legal Administrator and whose duties included Rulemaking, Official Gazette Notices and Patentability Guidelines; deciding petitions, including filing date petitions, that came under the authority of the Deputy Assistant Commissioner for Patent Policy & Projects; and special projects.

In his Declaration, Mr. Nase states that the USPTO changed its procedures relating to the treatment of *prima facie* incomplete applications effective July 22, 1996. In this regard, prior to July 22, 1996, the USPTO chose to treat applications filed without all pages of the specification as incomplete and did not accord, as a matter of policy, and notwithstanding 35 U.S.C. § 111 and 37 C.F.R. § 1.53(b), such applications a filing date (“the old missing page procedure”). The change in procedure effective July 22, 1996 treated applications filed without all pages of the specification as complete and accorded such applications a filing date (“the new missing page procedure”). Mr. Nase states that he undertook a review of all filing date procedures for handling pages omitted from an application filed under 37 C.F.R. § 1.53 and from that review concluded that there was no requirement in the statutes or regulations that an application filed under 37 C.F.R. § 1.53 include sequentially numbered pages, or all of the pages to obtain a filing date. Further, Mr. Nase notes in his Declaration that the Implemented Filing Date Notice (at 61 FR 30045) stated that the adopted procedure replaces “formalistic procedures with procedures based upon the requirements for a filing date as set forth in 35 U.S.C. §§ 111, 112, and 113.” Therefore, as the procedures in place at the time of deposit of this application were merely “formalistic procedures” and not a requirement of either the statute (35 U.S.C. § 111) or the applicable rule (37 C.F.R. § 1.53(b)), Mr. Nase states that it is his opinion that the instant application was entitled to the August 31, 1993 filing date under the statutes and regulations *in effect at that time*.

Mr. Nase’s Declaration further states that the Proposed Filing Date Notice (at 60 FR 56984) indicated that, due to the effect that the loss of a filing date can have on an application, the USPTO generally treats untimely filing date petitions on their merits since the application, as formalistically declared incomplete, will have undergone no further processing or examination. Applicant has no intention of further prosecuting the present application and is in fact authorizing the PTO to expressly abandon it once a filing date is formally accorded the present application. The present Petition is filed simply to perfect subsequent continuing applications which relied under 35 U.S.C. § 120 on the filing date of the present application. Applicant, the general public and indeed the USPTO were completely unaware of this imperfection until the issue was brought to light by an

opposer to Applicant's continuing application(s) in recent litigation. The PTO is well aware of many instances where an oversight goes undetected for many years until it is brought to light. Given that the grant of a filing date simply to cure an oversight relative to a formalistic requirement does not yield a windfall to applicants the way continued prosecution of that same application would, the PTO has historically considered filing date petitions of this type on their merits, even when their filing was delayed due to a lack of awareness that a problem existed. This PTO policy of treating untimely submitted filing date petitions on their merits was publicly announced in the above-noted Proposed Filing Date Notice (at 60 FR 56984).

The failure of the USPTO to grant filing dates in applications with a missing page but which otherwise included the specification, at least one claim and drawings, *was in direct contradiction to the statute and rule in effect at the time of filing*. This contradiction in policy with the statute and rule was recognized by the July 22, 1996 change in the manner in which applications with a missing page of the specification were handled. In this regard, the USPTO in its policy decision of July 22, 1996 disavowed the very practice that is still being unfairly applied to refuse the petition for a filing date in this application. The USPTO recognized that withholding a filing date merely because of the simple absence of a page or pages to the specification was inconsistent and clearly erroneous as a matter of law with the patent statute and rules then (and even now) in effect. The fact that the USPTO misapplied the statute, rule and procedures is clearly supported in comment (11) in the July 22, 1996 Change in Procedure Relating to an Application Filing Date, where members of the public suggested that the proposed procedure be adopted by rulemaking and also suggested that the proposed procedure either be adopted by rulemaking or clearly set forth in the MPEP, the following response is noted:

37 CFR 1.53(b)(2) provides that the "filing date of an application for patent filed under this section, except for a provisional application, is the date on which a specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75; and any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41." * * * **Thus, no change to the rules of practice is necessary to adopt the procedure set forth in this notice [emphasis added].**

As noted by Mr. Nase's Declaration, 35 U.S.C. § 111 provided that "[t]he filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office." Further, 37 C.F.R. § 1.53(b) provided that "[t]he filing date of an application for patent filed under this section is the date on which: (1) a specification containing a description pursuant to 37 CFR § 1.71 and at least one claim pursuant to 37 CFR § 1.75; and (2) any drawing required by 37 CFR § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by 37 CFR § 1.41." Mr. Nase's Declaration notes that, in this application, the USPTO did in fact receive 20 pages of drawings and 68 pages of the specification, including the claims. The 68 pages of the specification consisted of an unnumbered title page followed by 67 pages numbered 2-68. The 68 pages of the specification contained a description pursuant to 37 C.F.R. § 1.71 and at least one claim pursuant to 37 C.F.R. § 1.75. The 20 pages of drawings contained the drawings required by 37 C.F.R. § 1.81(a). The unnumbered title page set forth the names of the actual inventors as required by 37 C.F.R. § 1.41. However, as pointed out in Mr. Nase's Declaration, at the time of filing this application, there was no requirement that the first page of the specification be numbered and it was common for a first page of a document to be unnumbered even when the subsequent pages were numbered. In addition, 37 C.F.R. §§ 1.72(a) and 1.77 together permit the title of the invention to appear as a heading on the first page of the specification if it does not otherwise appear at the beginning of the application and that such title page may also state the name, citizenship, and residence of the applicant. Since a title page is considered to be part of the specification, it is Mr. Nase's expert opinion that this application, as filed on August 31, 1993, was not *prima facie* incomplete by omitting a page numbered 1. Further, although page 2 started in mid-sentence, this was a minor error correctable by a suitable amendment to that page.

2. October 29, 1993 Petition Was Grantable on its Face

Even though the USPTO erroneously maintains that this application was not entitled to the August 31, 1993 filing date for being incomplete by omitting a page numbered 1 and having page numbered 2 start in mid-sentence, the 2009 Decision further overlooks the fact that the former

missing page procedure in effect at the time should have resulted in the grant of a filing date. In that instance, as explained in Mr. Nase's Declaration, Applicants' October 29, 1993 petition under 37 C.F.R. §§ 1.53 and 1.182 for a filing date of August 31, 1993 was grantable at the time of filing thereof since the requirements of the old missing page procedure had been complied with. More specifically, the petition under 37 C.F.R. §§ 1.53 and 1.182 was accompanied by the \$130 fee and an amendment cancelling from the specification all incomplete sentences and renumbering the pages in consecutive order. The petition noted that no claims depended upon missing page 1 for disclosure and support. The petition also included a statement that the invention is adequately disclosed in, and that Applicants wish to rely on, the application as amended without the missing items and the references thereto in the specification, for purposes of an original disclosure and filing date. The sole reason the USPTO dismissed the petition under 37 C.F.R. §§ 1.53 and 1.182 was because a supplemental declaration from the inventors stating their intention to rely on the application without page 1 had not been submitted.

3. Requirement of Another Declaration Was Inconsistent with Statute and Regulations

Petitioner contends that the petition for filing date filed in this application on October 29, 1993 in reply to the September 14, 1993 Notice of Incomplete Application, did in fact, comply with the requirements for a filing date and, therefore, the USPTO erred in not granting a filing date of August 31, 1993 to this application. In this regard, the Notice of Incomplete Application of September 14, 1993, indicated that page 1 of the specification was missing and, as one option for a filing date, stated that a petition could be filed stating that the missing item was not necessary for a filing date. The Notice of Incomplete Application mailed by the USPTO on September 14, 1993 was also accompanied by a Notice to File Missing Parts of Application – No Filing Date (Notice), which advised Applicants that the basic filing fee, claims fee, and the oath or declaration were missing. The first paragraph of the September 14, 1993 Notice states:

Required items 1-9 below SHOULD be filed, with any items required on the "Notice of Incomplete Application" enclosed with this form. The filing date of this application will be the date of receipt of the items required on the "Notice of

Incomplete Application.” If items 1 and 3-6 below are submitted after the filing date, THE PAYMENT OF A SURCHARGE of \$130 large entities or \$65 for small entities who have filed a verified statement ***** will also be required [emphasis added].

Item 1 of the Notice is directed to the basic filing fee and item 3 is directed to the missing oath or declaration. The Notice also stated that these items SHOULD be filed with the items required by the Notice of Incomplete Application – it did not state that they ‘MUST’ be filed with the items required by the Notice of Incomplete Application. The fact that the filing fee and declaration did not have to be submitted with the response to the Notice of Incomplete Application is supported by the statement thereafter, which reads: “[i]f items 1 and 3-6 below are submitted after the filing date,” then payment of a surcharge would also be required. Therefore, applicants had the option to delay paying the filing fees and submitting the oath or declaration after the application was accorded a filing date. Further, attention is directed to MPEP Section 608.01, Fifth Edition, Rev. 15, August 1993, which states:

If any applicant believes that the omitted pages of the application are not necessary for an understanding of the subject matter sought to be patented, applicant may petition to have the application accepted without the omitted pages. Any petition must be accompanied by the petition fee (37 CFR 1.17(h)) and an amendment canceling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and renumbering the pages present in consecutive order. Also, if the oath or declaration for the application was filed prior to the date of the amendment and petition, the amendment must be accompanied by a supplemental declaration by applicant stating that the invention is adequately disclosed in, and a desire to rely on, the application as thus amended for purposes of an original disclosure and filing date. If the oath or declaration for the application was not filed prior to the date of the petition and amendment, the oath or declaration, when filed, must include a specific reference to the amendment cancelling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and support. [Emphasis supplied].

As this application was filed without an oath or declaration and no oath or declaration was filed prior to the date of the petition under 37 C.F.R. §§ 1.53 and 1.182 and accompanying amendment, the USPTO’s own procedures did not require the submission of an oath or declaration as a condition

for a grantable petition for a filing date. Therefore, the USPTO erred in its decision of February 16, 1994 by requiring a supplemental oath or declaration when, in fact, no oath or declaration had ever been filed in this application.

MPEP Section 601.01, the pertinent MPEP edition in effect at the time of the filing of this application, includes a list of all the forms used by Application Branch to notify applicants of defects in their applications. Among these forms is a Notice to File Missing Parts of Application- No Filing Date. The first paragraph of that form states that the Office is bringing to petitioner's attention at this time that a surcharge would be required "if items 1 and 3-6 [which here would include items 1 and 3 for the filing fee and oath or declaration] are filed after the filing date." This form, after item 8, includes the following language:

Required items 1-7 above SHOULD be filed, **if possible**, with any items required on the "Notice of Incomplete Application" enclosed with this form. If concurrent filing of all required items is not possible, items 1-7 above must be filed no later than two months from the filing date of this application. The filing date will be the date of receipt of the items required on the "Notice of Incomplete Application." If items 1 and 3-6 above are submitted **after** the filing date, THE PAYMENT OF A SURCHARGE OF \$ ____ for large entities, or \$ ____ for small entities who have filed a verified statement claiming such status, is required. (37 CFR 1.16(e)).

Applicant must file all the required items 1-7 indicated above within two months from any filing date granted to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). [Emphasis supplied].

As noted by Mr. Nase in his Declaration, the version of the Notice to File Missing Parts of Application mailed by Application Division on September 14, 1993 was not the same version of the Notice reproduced in MPEP Fifth Edition, Rev. 15, August 1993, the version in effect at the time of filing of this application. The version mailed by Application Division did not set a two month period for submission of the missing items, while the version in effect at the time of filing this application did set a two month period from the filing date of the application for the submission of the missing items. Nevertheless, except for this difference, the language in both Notices makes it

clear that the filing fee and oath or declaration could be submitted after a filing date has been accorded the application.

MPEP Section 601.01 Fifth Edition, August 1993, states, in part:

37 CFR 1.53(b) provides that a filing date is assigned to an application as of the date a specification containing a description and claim and any required drawings and the names of all inventors are filed in the Patent and Trademark Office. Failure to meet any of the requirements in 37 CFR 1.53(b) will result in the application being denied a filing date. The filing date to be accorded such an application is the date on which all the requirements of 37 CFR 1.53(b) are met. Although the filing fee and oath or declaration can be submitted later, no amendments can be made to the specification or drawings which will introduce new matter. * * *

Effective February 27, 1983, in accordance with the provisions of 35 U.S.C. 111 and 37 CFR 1.53(b), **a filing date is granted to an application for patent, which includes at least a specification containing a description pursuant to 37 CFR 1.71 and at least one claim pursuant to 37 CFR 1.75, and any drawing referred to in the specification or required by 37 CFR 1.81(a),** which is filed in the Patent and Trademark Office and which names the actual inventor or inventors pursuant to 37 CFR 1.41(a) [emphasis added].

The statute at 35 U.S.C. § 111 in effect at the time of the filing of this application stated: “[t]he fee and oath may be submitted after the specification and any required drawings are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Commissioner.” Further, 37 C.F.R. § 1.53(d) in effect at the time of filing this application, stated: “[i]f an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the appropriate filing fee or an oath or declaration by applicant, the applicant will be so notified * * * and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in §1.16(e) in order to prevent abandonment of the application.” As this application was not accorded a filing date, the basic filing fee or oath or declaration were not required as a condition for the granting of a filing date to this application. All that Applicants were required to do at the time of filing the petition for filing date on October 29, 1993 was to file a petition and fee stating that the omitted page was not necessary

for an understanding of the invention and, according to the procedures in effect at the time, as noted above in MPEP 608.01, file an amendment canceling from the specification all incomplete sentences and any claims which depend upon the omitted pages and renumbering the pages present in consecutive order. However, it is noted that, while the Notice of Incomplete Application itself did not make a requirement for an amendment to the specification, Petitioner not only timely filed the petition for filing date, making the statement that the omitted page was not necessary for an understanding of the invention, but also included the amendment to the specification. Despite Applicants' compliance with the Notice of Incomplete Application, the USPTO arbitrarily refused to grant a filing date to the timely filed petition of October 29, 1993 because the petition was not accompanied by a supplemental oath or declaration, which refusal was in direct contradiction to the procedure set out in both the Notice to File Missing Parts of Application mailed on September 14, 1993 and the statute, rule and MPEP guidelines. The decision dismissing the petition of October 29, 1993 was not based on the USPTO's own stated internal policy.

Therefore, not only was this application entitled to a filing date on filing, but was again entitled to the filing date of August 31, 1993 in view of the timely filing of the October 29, 1993 petition wherein Applicants had clearly satisfied the requirement in the Notice of Incomplete Application for a filing date.

The USPTO decision of February 16, 1994 was clearly in error in that (1) it did not then grant the requested filing date of August 31, 1993; and (2) conditioned any future grant on the submission of a supplemental oath or declaration. As Applicants had complied with the requirements for the granting of a filing date, Mr. Nase states in his Declaration that the decision of February 16, 1994 should have granted the petition of October 29, 1993 and the decision should have either (1) set an extendible period for submitting the filing and surcharge fees and the oath or declaration, or (2) returned the application file to Application Branch for mailing of a Notice to File Missing Parts of Application-Filing Date Granted setting an extendable period for submitting the filing fees and oath or declaration. Instead, the decision of February 16, 1994 set a non-extendable period of two months for submitting a supplemental oath or declaration. Had Applicants been

properly given an extendable period under the provisions of 37 C.F.R. § 1.136(a) in the decision of February 16, 1994, then Applicants could conceivably have had sufficient time to obtain the required declaration executed by all the inventors and/or filed a petition under 37 C.F.R. § 1.47(a) to accept the declaration by less than all the inventors. This statement is supported by the fact that an executed declaration by all the available inventors and a petition under 37 C.F.R. § 1.47(a) were filed on August 29, 1994 in the continuing '985 application. Therefore, it was because of this very fatally flawed decision that Applicants were forced to file the '985 application due to the difficulties encountered in obtaining a declaration executed by all the named inventors within the non-extendable two month time period set in the decision of February 16, 1994.

Mr. Nase further states in his Declaration that it is his opinion that the declaration by the applicants submitted in the '985 continuing application in support of the 37 C.F.R. § 1.182 petition in the '985 application should be considered sufficient to correct the deficiency in the 37 C.F.R. §§ 1.53 and 1.182 petition in this application that was noted in the February 16, 1994 dismissal of the petition of October 29, 1993. In this respect, the '985 application was filed on February 28, 1994, which also was missing the title page of the specification. In the '985 application, a petition was timely filed on September 11, 1995 requesting that the application be accorded a filing date of February 28, 1994. The petition to accord the '985 application the original filing date of February 28, 1994 was granted on September 15, 1995, which decision also granted the petition under 37 C.F.R. § 1.47(a) to accept the application without the signatures of all the inventors. Therefore, as the facts in the instant application and the continuing '985 application were the same, Mr. Nase's Declaration submits that the September 15, 1995 grant of the petitions in the '985 application, *sub silentio*, granted relief in the underlying '955 application.

4. PTO's Later Action Contradicted Treatment of '955 Application

Attention is further drawn to the '985 continuing application, which application was filed on February 28, 1994, prior to the effective July 22, 1996 filing date change, and which also was missing a page of the specification. However, that application was granted a filing date, which was

in direct contradiction to the USPTO's handling of the petition filed in the '955 application. Therefore, it appears that the USPTO was inconsistent with its own flawed procedures in the treatment of applications filed without all pages of the application. In response to a petition filed on September 11, 1995 in the '985 continuing application requesting that the application be accorded a filing date of February 28, 1994, the USPTO, on September 15, 1995, prior to the effective July 22, 1996 filing date change, granted petitioner's request for the original filing date of February 28, 1994 (and also granted a petition under 37 C.F.R. § 1.47(a) to accept the application without the signatures of all the inventors). The USPTO maintained in the 2009 Decision that Petitioner cannot rely upon later promulgated statutes, rules, and procedures to support his assertions that a filing date of August 31, 1993 be granted to the instant application. Therefore, the position of the USPTO in not granting a filing date, on the same facts, is arbitrary and capricious.

For the above reasons, the USPTO's decisions not to grant this application a filing date were arbitrary, capricious and contrary to law then and now in effect. The USPTO recognized that its practice was not consistent with the statute and rules by its implementation of a policy that an application is entitled to a filing date where it contains a specification, at least one claim, and any required drawing, even though all the pages of the specification were not present on filing. The USPTO in its policy decision of July 22, 1996 disavowed the very practice that is still being arbitrarily applied to refuse the petition for filing date in this application. Accordingly, Petitioner is entitled to the requested filing date of August 31, 1993 and requests that this application be so accorded that date.

B. ARGUMENTS AS TO WHY PETITION FOR FILING DATE SHOULD BE CONSIDERED TIMELY

The 2009 Decision again refused to consider the petition for filing date on the basis that it was not timely submitted. In this regard, the decision stated that Petitioner was thrice put on notice, "not only in the letter mailed by Application Division on September 14, 1993 but also in the petition decision mailed February 16, 1994, that the above-identified application did not have a filing date

and was further made aware by such petition decision what was required in order to obtain a filing date.” The 2009 Decision further stated that the Notice of Abandonment provided even further notice of the lack of a filing date. Moreover, the Decision states that petitioner was given two months from the mailing date of the February 16, 1994 petition decision to file a request for reconsideration, but chose not to file such request and that to now state that petitioner was first notified of the lack of such filing date on October 5, 2007 is misplaced.

As to the Notice of Incomplete Application mailed September 14, 1993 by Application Division to Applicants’ counsel, Mr. Grossman, Petitioner submits that the Notice was in fact timely responded to on October 29, 1993, which response was well within the two month period set therein. However, despite the fact that all the conditions for a grantable petition for filing date had been satisfied, the USPTO arbitrarily and erroneously dismissed the petition for the reasons noted *supra*. Nevertheless, in an attempt to satisfy the conditions set out in the February 16, 1994 petition decision, a four month extension of time and a continuing application were filed on February 28, 1994. However, the continuing application was also filed with the first page of the specification missing but was nevertheless granted a filing date. The fact that the continuing application was considered by the USPTO to have been improperly accorded a filing date was not brought to the attorney’s attention until a telephone conversation with Ms. Magdalen Y.C. Greenlief , whereupon a petition for filing date was promptly filed. The petition for filing date was granted, along with the petition under 37 C.F.R. § 1.47(a). It would have been reasonable for Applicants to be under the impression that Ms. Greenlief had also reviewed this case at the time of deciding the petition for filing date in the continuing application (as she would have had to before granting a filing date to a continuing application) and that, by granting the petition for filing date, also blessed the filing date issue in the present application. It has been shown that the February 16, 1994 decision by the USPTO was in error and that such error was recognized by the granting of the requested relief for filing date by Ms. Greenlief in continuing Application No. 08/202,985. To now hold that the petition for filing date is untimely is unfair because Applicants were unaware that there was a problem until so apprized on October 5, 2007 by the defendants in a litigation suit involving this

case. This is especially true in view of the fact that Applicants received not one, but two, filing receipts which indicated co-pendency with both this application and the '985 continuing application. Further, the patent which issued from the '985 application included a priority claim to grandparent Application No. 07/426,917, as well as to the present application. Therefore, Petitioner had no reason to believe there was a problem in co-pendency between this application and the '985 continuing application. The issuance of the two filing receipts and printing of the claim for benefit of priority on the Letters Patent to both the grandparent and parent applications led Applicants into a false sense of security that there was no issue with the copendency requirements. It is further noted that 37 C.F.R. § 1.131 declarations were filed in the '985 continuing application by some of the inventors on March 17, 1998 stating that he is a "co-inventor of the above-identified application, which is a cont. of App. Ser. No. 08/113,955, filed 8/31/92, now abn'd, which is a continuation of app. Ser. No. 07/426,917, filed 10/26/89, Pat. No. 5,241,671." This further reinforces the belief that Applicants were unaware of any copendency problems.

The 2009 Decision further stated that 1059 *Off. Gaz. Pat. Office* 4 is inapplicable here where applicant was informed of both the lack of a filing date in and the abandoned status of this application and holding that the action here was nothing like the discontinued practice of filing a File Wrapper Continuing case under 37 C.F.R. § 1.62. However, Petitioner cited this Notice as analogous to the facts of this case since the USPTO not only issued two filing receipts, but also printed the claim for priority on the front page of the patent which issued from the '985 continuing application. As noted above, Applicants could have reasonably believed that the filing date issue in this case was resolved by the decision by Ms. Greenlief granting the petition for filing date in the '985 continuing application, and the USPTO reinforced and contributed to this belief by the issuance of the two filing receipts and by printing the priority information of the grandparent and parent applications on the front page of the Letters Patent.

Further, in support of Applicants' position that the USPTO contributed to Applicants' lack of awareness of the true status of this application relative to the copendency requirement of the '985 application, Petitioner points out that, in five other applications, the USPTO gave full weight and

credit to a claim for benefit of priority back to the present application, as well as to the very first application in this chain, namely, Application No. 07/426,917, filed October 26, 1989. The five applications affected by the priority claim to this application are listed below:

Application No. 10/103,814, filed March 25, 2002, now Pat. No. 6,978,277, which issued on December 20, 2005.

Application No. 11/150,494, filed June 13, 2005, now Patent No. 7,082,437, which issued on July 25, 2006.

Application No. 11/150,812, filed June 13, 2005, now Patent No. 7,051,081, which issued on May 23, 2006.

Application No. 11/150,813, filed June 13, 2005, now Patent No. 7,085,778, which issued on August 1, 2006.

Application No. 11/490,263, filed July 21, 2006, now pending.

In the first four applications cited above, the PTO issued filing receipts claiming benefit of priority to this application, as well as to the very first application in the chain (the '917 application), and all issued with the priority claim to this application and to the '917 application printed on the patent grant. The last application, No. 11/490,263, is still pending, and the claim for benefit of priority to the present application, as well as to the very first application in the chain (the '917 application), appears on the filing receipts issued in this application. Additionally, a review of the examination history of the above cases indicates that even the Examiner's computer searches of the prior art patents, pre-grant publications, and the foreign patent literature are limited to references having an effective date earlier than that of the October 26, 1989 date of the very first application filed in this chain of applications. Additionally, the pre-grant publications of these applications also include a claim for benefit of priority back to the first application filed, as well as to the present application. A chart, *infra*, is included in this petition to show the USPTO's actions in the above cases for a period spanning 14 years, a record that fails to bring to light any failure by Applicants to have perfected the filing date of the present application which was being relied on for continuity purposes. These are all positive, documented, official acts by the USPTO, that are also publicly

available, to show that the USPTO has both in its procedural roles, and in its examining roles acknowledged and accorded benefit of the claim for priority under 35 U.S.C. § 120 to this application as if it had properly been accorded a filing date and the entire chain of continuity been met. The 2009 Decision does just that—it denies the role that the USPTO has had for the last 14 years in causing or contributing to the Petitioner's (and the members of the public's) failure to appreciate that, in fact, the USPTO does not consider this application to have been accorded a filing date.

The courts have made it clear--that when, as here, the USPTO causes or contributes to a condition ultimately adverse to an applicant--the USPTO is obligated to exercise its remedial powers and remedy the situation. *See Helfgott & Karas, P.C. v. Dickinson*, 209 F.3d 1328, 1336 (Fed. Cir. 2000). ("Even if total elimination of mistakes is an illusory goal, their reasonable mitigation should not be.") Here, as the USPTO acknowledged in the July 22, 1996 Change in Procedure Relating to an Application Filing Date that no statute or regulation would have been violated on August 31, 1993 -- much less today -- in granting this application a filing date of August 31, 1993, there is no bar to that mitigation.

Chart of Bold-faced Positive, Documented, Official Acts by USPTO according § 120 benefit to US App. No. 07/426,917 (now US 5,241,671) through U.S. Application No. 08/113,955

App. No. PGPUB# Pat. No.	1989	1990	1991	1992	1993	1994	1995	1996	1997-01*	2002	2003	2004	2005	2006	2007	2008	2009
07426917 5,241,671																	
08113955																	
08202985 6,546,399						FR	FDPG	OA		OA	PD						
10103814 124004A1 6,978,277										FR PGP		SS OA	SS PD				
11150494 262066A1 7,082,437												FR PGP	SS OA	SS OA PD			
11150812 251515A1 7,051,018													FR PGP SS OA	SS OA PD			
11150813 262073A1 7,085,778												FR PGP SS OA	SS OA PD				
11490263 179977A1														FR	PGP CFR		OA

- USPTO suspended prosecution in 08/202,985 from 8/97 through 3/02

Shaded Area= Application/ PreGrantPub/Patent timeline

Legend

FR= Filing Receipt listing § 120 benefit claim GPG=PGPub listing § 120 claim
 CFR= Corrected Filing Receipt listing § 120 benefit claim PD=Patent Issued listing § 120 claim
 FDPG= Filing Date Petition Granted
 SS= Examiner's Search Strategy according § 120 benefit
 OA=Examiner's Office Action applying prior art based on § 120 benefit

As stated above, the above-noted applications all included either on the filing receipts, the patent grants, or the pre-grant publications, a claim for benefit of priority back to this application, as well as to the very first application filed in the chain. The USPTO's statement that, for Petitioner "to

now state that petitioner was first notified of the lack of such filing date on October 5, 2007 is misplaced,” is grossly unfair and unfounded in view of the numerous contributory acts, as shown further in the chart above, by the USPTO which led Applicants to reasonably believe that this application was properly and successfully given a filing date in order to perfect the benefit of the claim for priority in the ‘985 application (as well as the other continuing applications). In view of the continued prosecution from October 26, 1989 to the filing of the July 21, 2006 application, and the fact that the USPTO gave full weight and credit to the priority claims in all the applications back to the present application, as evidenced by the USPTO’s own record, lulled Applicants into a false sense of security believing that there was no issue with copendency between this application and the ‘985 application. Because of the contributory acts by the USPTO, *Applicants were unaware of any issues as to lack of copendency between this application and the ‘985 application until October 5, 2007.* Once Applicants became aware of the asserted issue, a petition for filing date was promptly and timely filed.

The USPTO’s contention that Petitioner has not shown or alleged that the general public will not be harmed by the granting of the desired filing date in this “long-abandoned application,” Petitioner contends that the public is unharmed because it was unaware of any asserted copendency issue between this application and the ‘985 application, especially in view of the USPTO’s issuance of patent grants in four other continuing applications, giving full weight and benefit to a claim for priority to this application. As the public was unaware of any problem for a period spanning at least 14 years, to now formally grant a filing date of August 31, 1993 to this application would cause no harm to those relying upon the filing date of this application. As noted in the Declaration by Mr. Nase, due to the effect that the loss of a filing date can have on an application, the USPTO generally treats untimely filing date petitions on their merits since the application, as incomplete, will have undergone no further processing or examination (as in the present case). The USPTO has recognized the unfairness of the harsh consequences that applicants may suffer when a filing date is not granted under these types of circumstances.

Accordingly, for the above reasons, Petitioner contends that, due to the contributory actions by the USPTO in the issuance of filing receipts, patent grants, and pre-grant publications with a claim for benefit of priority between this application and the '985 application, as further evidenced by the Examiner's computer searches, this petition for granting of a filing date was promptly filed once Applicants were notified on October 5, 2007 of an asserted lack of copendency in a litigation suit involving this application. Therefore, Petitioner respectfully requests that the USPTO grant the timely filed petition for a filing date of August 31, 1993 to this application.

C. DISCUSSION OF FILING FEE ISSUE

The 2009 Decision stated that, despite petitioner's statement that the fees should be reallocated in view of a blanket fee authorization given in the February 28, 1994 petition for extension of time, no blanket fee authorization was given; that the only authorization was one to charge extension of time fees; that the statement in the petition for extension of time that "the commissioner is authorized to charge any fee or additional amounts due in connection with this communication," was not a blanket authorization to charge the filing fee, additional claim fees, and surcharge fee; that to do so would be wholly inappropriate since the attorney, Mr. Grossman, did not intend such in view of his failure to respond to the petition decision of February 16, 1994; and that 37 C.F.R. § 1.22(b) required an itemization in such a manner that it was clear for which purpose the fees are paid. The 2009 Decision construed the authorization solely as one to charge an extension of time fee and that no reallocation of fees will be undertaken. Further, the USPTO will not accept any fees at this time since no filing date has been granted and proceedings have been terminated.

The petition for extension of time filed February 28, 1994, included the following statement:

A check in the amount of \$1,320.00 is attached. If no check is attached and a fee is due or if the check enclosed is insufficient, the Commissioner is authorized to charge any fee or additional amounts due in connection with this communication to Deposit Account No. 04-1073.

Mr. Nase states in his Declaration that it is his opinion that the fee language set forth in the February 28, 1994 extension of time request filed in this application was sufficient authorization to charge the processing and retention fee as then provided by 37 C.F.R. § 1.21(l). As the extension of time noted that a continuation application under 37 C.F.R. § 1.53 was being filed on that same day, it is clear that the fee required in connection with this communication would have been payment of the retention fee in order to claim benefit of priority under 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a) then in effect. Mr. Nase further notes in his Declaration that, while 37 C.F.R. § 1.22(b) provided that all patent fees paid to the USPTO should be itemized in each individual application in such a manner that it is clear for which purpose the fees are paid, 37 C.F.R. § 1.22(b) does not require such itemization. The practice of the USPTO did not require an itemization in order to charge a fee to a deposit account. As an example, a claim amendment which requires additional claim fees would have needed claim fees charged to a deposit account if there was a general authorization to charge any fee due. Therefore, Mr. Nase's Declaration states that it is his opinion that the fee language set forth in the February 28, 1994 extension of time filed in this application was sufficient authorization to charge the processing and retention fee as then provided by 37 C.F.R. § 1.21(l).

Mr. Nase states in his Declaration that, for the reasons given, this application is entitled to the August 31, 1993 filing date under the statutes, regulations and procedures in effect at that time. It is Mr. Nase's further opinion that, the Notice to File Missing Parts of Application mailed on September 14, 1993 did not set a time period for paying the appropriate filing and surcharge fees and for submitting the oath or declaration. As noted above, the decision mailed on February 16, 1994 should have been granted and, pursuant to the missing parts practice, the decision should either (1) have set an extendible period for submitting the filing and surcharge fees and an executed oath or declaration (or, in this case, a petition under 37 C.F.R. § 1.47(a)), or (2) returned the application file to Application Division for the mailing of a Notice to File Missing Parts of Application – Filing Date Granted, setting an extendible period for supplying the missing parts. It is further Mr. Nase's opinion that, since this application is still pending with a filing date of August 31, 1993, it is still possible for Applicants to timely pay the filing fees. In the event that the PTO

Deciding Official finds that the filing fees must be paid at this time and that any unnecessary payments previously made be refunded, the PTO is hereby authorized to charge the filing fees to Petitioner's Deposit account given below.

Should the USPTO still consider that this application is not entitled to the August 31, 1993 filing date, it is pointed out that, at the time of filing the petition for extension of time, this application had not been formally accorded a filing date as a result of the USPTO's unfortunate actions or inactions herein. Therefore, as this case, according to the USPTO, had not been accorded a filing date, it follows that no filing fees were due and no extension of time fees were owed, since extension of time fees under 37 C.F.R. 1.136(a) *are only applicable to pending applications*. As such, the \$1,320 extension of time fee submitted was a fee paid where no fee was due; yet, this fee was accepted by the USPTO and has not been refunded. This retained fee is more than enough to cover the basic filing fee, or certainly the \$130 processing and retention fee, which was the minimum fee then owed, that permitted an applicant under then 37 C.F.R. § 1.78, even in an incomplete application, to present a claim for benefit of priority under the rule to a prior application. Therefore, upon the granting of a filing date to this application, Petitioner requests that the USPTO apply the superfluous extension of time fee long ago paid to the USPTO, and, despite not being owed to the USPTO, still in the possession of the USPTO, toward the filing fee and/or retention fee. In this regard, while the processing and retention fee of former 37 C.F.R. § 1.21 no longer exists, the USPTO has maintained that it will apply the rules in effect at the time this application was filed to this application. Petitioner points out that, at the time this application was filed, 37 C.F.R. § 1.78(a) permitted an applicant to claim benefit of a prior application even if it was itself incomplete, or the prior application was itself incomplete, (*i.e.*, did not have a declaration and/or had not paid the entire filing fee), so long as \$130 of the processing and retention fee set forth in 37 C.F.R. § 1.21(l), was paid. *See* 37 C.F.R. § 1.78(a) (1993). Here, Petitioner has paid at least 10 times the amount needed for any priority claim to the USPTO. Therefore, the USPTO had in its possession the fee necessary to comply with the filing fee requirements and 37 C.F.R. § 1.78(a). Furthermore, the PTO did not and does not have a practice of requiring itemization as in "must" itemize, or else

the fee will not be accepted. Rather, it was always as in "should" be itemized in order to ensure proper fee application by the PTO.

D. MISCELLANEOUS COMMENTS

The 2009 Decision maintained that *Korsinsky* (*Korsinsky v. Godici*, 2005 U.S. LEXIS 20850 (2005)) is applicable to the present situation (see 2009 Decision, top of page 9). The 2009 Decision states that, in both cases, (1) "petitioner deliberately chose a course of action" and (2) later, "due to infringement," "realized... the error of that previous decision," and "chose an opposite course of action." In fact, the two cases are plainly and fundamentally different in both respects.

With respect to the first point, the reason *Korsinsky* did not pay maintenance fees when they were due was because his wife thought the money was not worth it. Basically, he just walked away from his patent because he did not want to spend the money. In contrast, the Applicants in the present case at all times took steps seeking to maintain the pendency of at least one patent application, to preserve copendency to the original October 26, 1989 filing date. At every turn, the Applicants took at least some action that can only be understood as an effort to maintain copendency.

The "error" in *Korsinsky's* case was that he made a bad business decision. He (or at least his wife) thought that the patent was not worth the maintenance fee, and so he let it expire. Then he wanted to change his mind when it was learned that the patent might have value. The present case is very different. Applicant never made a business decision to walk away from copendency through the '955 application. The "error," if any, was a formalistic one brought to its attention by a third party in ongoing litigation -- a third party with substantial resources and incentive to uncover any possible procedural irregularity.

On the issues of timeliness, and the applicability of the Rules, the Helfgott case is much more analogous to the present case -- more analogous than Korsinsky. In the Helfgott case, the applicant made a mistake. He filed a PCT Demand incorrectly. The PTO compounded the error in a way that made it more difficult for Helfgott to realize in a timely fashion that there was any problem. Helfgott's petition for relief was dismissed as untimely. The Federal Circuit determined that the PTO's refusal to grant relief under Rule 183 was an abuse of discretion.

The 2009 Decision states in the middle paragraph of page 9 that the requirements of the Office letter of September 14, 1993, the Decision of February 16, 1994, and MPEP 608.01 have yet to be met, and in any event, were not timely met. Petitioner respectfully requests clarification on this point. All fees have been authorized to be charged to Petitioner's deposit account, including any filing fees, additional claim fees and surcharge required. The Supplemental Declaration indicating the inventors agreement that the invention is adequately disclosed without original page 1 has been filed. Thus, all requirements have in fact been met. The fact that the requirements were timely met, has been discussed at great length above.

The 2009 Decision indicates in the penultimate paragraph of page 11 that Petitioner has not shown nor alleged that the general public will not be harmed by the granting of the desired filing date. Continuing applications filed from the present application made clear that benefits to this application as well as its parent application were being claimed. Upon review of the present application and the '985 application, the only possible conclusion one can draw is that the present application was abandoned in favor of the '985 application. It is therefore clear that the invention covered by the '955 application was never abandoned. It is only the file of the '955 application that was allowed to be abandoned in favor of one or more continuing applications. The equity is clearly on Applicants' side.

The 2009 Decision indicates at the bottom of page 11 that the declarations submitted are not in compliance with MPEP 608.01 (Fifth Edition Rev. 15) and in any event are untimely.

Clarification is respectfully requested as to the nature of lack of compliance. Again, the timeliness issue has been addressed above.

Request to amend this application for priority to Application No. 07/426,917

As it is Petitioner's position that this application is pending and entitled to the filing date of August 31, 1993, Petitioner submits that the requirements for claiming benefit of priority under 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a) have long since been satisfied. Therefore, Petitioner again requests that this application be amended to formally claim benefit of priority to Application No. 07/426,917. The amendment was first submitted with the petition of November 1, 2007.

Relief Requested

In sum, Petitioner requests the USPTO to:

- (1) formally accord a filing date of August 31, 1993 to this application for the reasons given above;
- (2) apply the processing and retention fee in effect at the time this application was filed by reallocating the fee from the \$1,320 extension of time fee still in the possession of the USPTO, and refund the balance of the extension of time fee;
- (3) or, if the USPTO deems that the filing fee should be paid, then Petitioner requests that the filing fee be reallocated from the \$1,320 extension of time fee and the balance be refunded;
- (4) amend this application to claim priority to Application No. 07/426,917 and issue a filing receipt therefor; and
- (5) if necessary, take appropriate action on the Petition under 37 C.F.R. § 1.47(a) (that Petition was simply filed at the urging of the PTO deciding official in the initial


dismissal of the Petition, but is not believed to be necessary as Applicant does not wish to further prosecute this application other than having a filing date granted and then having it re-abandoned in favor of the continuation applications already on file).

- (6) The USPTO is authorized to charge any fees required for a grantable petition, including, but not limited to, any retention fees, filing fees, or petition fees to Deposit Account No. 50-2929, making reference to Docket Number J8300.1.

The Deciding Official is invited to contact the undersigned with any unresolved issue that would lead to a favorable decision on this Request/Petition.

Dated: May 4, 2009

Respectfully submitted,

By 

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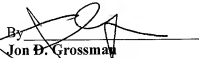
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